

REMARKS

The Applicant thanks the Examiner for the consideration given the present application in the Office Action mailed January 05, 2011, the Advisory Action dated April 18, 2011, and the Interview conducted with Examiner Gebremichael on April 29, 2011.

Claims 5 and 22 are cancelled herein without prejudice to or disclaimer of the subject matter contained therein. Claims 11 and 14-16 was previously cancelled. Claims 1-10, 12, and 17-22 are pending. Claims 1, 8, and 17-19 are amended. Claims 1 and 17 are independent. The Examiner is respectfully requested to reconsider the rejections in view of the amendments and remarks set forth herein.

Examiner Interview

The Applicant wishes to thank Examiner Gebrumichael for the courtesies extended to Applicant's Representative, Carl T. Thomsen, Registration No. 50,786, during the telephone interview which was conducted on April 29, 2011.

During the interview on April 29, 2011, the Applicant's Representative pointed out to the Examiner that the Office Actions dated October 8, 2010 and January 5, 2011, and the Advisory Action dated April 18, 2011, continued to reject the claims of the present invention using the same cited references reversing the Examiner's agreement in a previous interview on October 7, 2010 and the Interview Summary dated October 13, 2010 which stated that

"The Examiners indicated that the proposed claim(s) amendments overcomes the current rejection; and therefore, additional search will be conducted when the response is filed."

Further, during the interview of April 29, 2011, the Applicant's representative expressed frustration with the Examiner's repeated reversal of the statement made in the Interview Summary dated October 10, 2011.

However, as the interview continued, the Examiner stated that the Applicant could place the application in condition for allowance by making the following amendments to the claims:

- Amend independent claims 1 and 17 to include the following subject matter:

“wherein said riding simulation apparatus is adapted to be mounted on a standard household table, and

since the control unit is mounted such that the lengths of the lateral sides of the control unit are parallel to the downwardly sloping linear portions, the control unit is mounted completely away from an upper side of the standard household table.”

(The above subject matter was previously set forth *verbatim* in now-cancelled dependent claims 5 and 22, except for minor words changes suggested by the Examiner, namely to substitute the words “standard household table” for the words “elevated mounting surface,” in each of these claims.)

- Dependent claims 5 and 22 have been cancelled to reflect the changes to independent claims 1 and 17,
- dependent claim 8 has been amended to depend from independent claim 1, and
- Dependent claims 18 and 19 have been amended to overcome the rejection under 35 U.S.C. 112, first paragraph.

By way of this Amendment, the claims have been amended precisely as discussed during the interview, and are believed to place the application into condition for allowance. Accordingly, reconsideration and allowance of the present application are respectfully requested.

If, during further examination of the present application, a discussion with the Applicant's Representative would advance the prosecution of the present application, the Examiner is encouraged to contact Carl T. Thomsen, Registration No. 50,786, at 1-703-208-4030 (direct line) at his convenience.

Reasons for Entry of Amendments

First of all, the Examiners' Interview Summary dated October 13, 2010 which summarized the results of the interview conducted with Examiner Bruk Gebremichael and his supervisor (Cameron Saadat) on October 07, 2010, with the Applicant's Representative (Carl Thomsen, Reg. No. 50,786), stated that

"The Examiners indicated that the proposed claim(s) amendments overcomes the current rejection; and therefore, additional search will be conducted when the response is filed."

The response filed on October 8, 2010 included claims exactly as presented to and discussed with the Examiners on October 7, 2010. Despite the statement made in the Interview Summary, the latest Office Action fails to cite any new prior art references and rejects the claims based on the same combination of previously cited references.

The Applicant fails to understand the rationale and logic for Examiners' reversal of opinion stated in the Interview, and his repeated rejections of the claims based on the previously cited prior art.

In response to this latest Office Action, the Applicant respectfully submits that claims as filed on October 8, 2010 presented are in condition for allowance.

Further, the Applicant submits that the combinations of references cited in the latest Office Action to reject these claims are not proper and should be withdrawn. (See arguments below.)

While not conceding the appropriateness of the Examiner's repeated rejections, and based on the Examiner's explicit statements in the Interview dated April 29, 2011, the Applicant has now further amended each of **independent claims 1 and 17** as indicted above.

Therefore, it is respectfully requested that this Reply be entered into the Official File in view of the fact that the pending claims automatically place the application in condition for allowance.

Further, all of the subject matter now set forth in each of the pending claims has been fully considered and examined by the Examiner. As such, the pending claims do not raise any new issues that would warrant or require the Examiner to perform an additional search of the related art.

In the alternative, if the Examiner does not agree that this application is in condition for allowance, it is respectfully requested that this Reply be entered for the purpose of appeal. This Amendment reduces the issues on appeal by placing claims 18 and 19 in compliance with 35 U.S.C. § 112, first paragraph, and by cancelling allowable claim 5 and 22 and incorporating the limitations thereof into **independent claims 1 and 17**.

Rejection Under 35 U.S.C. § 112, first paragraph

In the Office Action dated January 5, 2011, the Examiner rejected claims 18 and 19 under 35 U.S.C. § 112, first paragraph.

However, in the Advisory Action dated April 18, 2011, the Examiner indicates that this rejection may be overcome by amending each of dependent claims 18 and 19 to replace the words “cross pipe,” with the previously-examined words “cross frame.”

Inasmuch, as claims 18 and 19 were previously examined with the words “cross frame,” the Examiner cannot argue that new issues have been raised by these amendments. Reconsideration and withdrawal of this rejection are respectfully requested.

Rejections Under 35 U.S.C. §103(a)

Claims 1, 3-6, 8-10, 12, 13, and 17-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Caprai (U.S. Patent 6,251,015) in view of Ritchie (U.S. Patent 4,637,605); and claims 2 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Caprai and Ritchie, and further in view of Pittarelli (U.S. Patent 3,964,564).

These rejections are respectfully traversed.

Independent Claims 1 and 17 as Amended

Independent claim 1 has been amended merely to include subject matter set forth in independent claim 17 and dependent claim 5 as previously presented.

As such, **independent claim 1** now recites a combination of elements directed to a riding simulation system, including *inter alia*

“a control unit for said system being mounted in a position between downwardly sloping linear portions of said pair of left and right main frames and under the centrally located main frame,

lateral sides of the control unit **16** having lengths which are parallel to the downwardly sloping linear portions **52ad, 52bd**,

the position of the control unit **16** being such that most of the control unit **16** extends below where the sub-frames **54a, 54b** are connected to the downwardly sloping linear portions **52ad, 52bd** of left and right main frames, the position of the control unit **16** being rearward with respect to each of the sub-frames **54a, 54b**,

wherein each of the left and right main frames **52a, 52b** includes a horizontal linear portion **52ah, 52bh** extending from a lower end of the corresponding downwardly sloping linear portion **52ad, 52bd** in the direction away from the operator of the simulation system and parallel to the corresponding sub-frame **54a, 54b**,

wherein said riding simulation apparatus is adapted to be mounted on a standard household table, and

since the control unit **16** is mounted such that the lengths of the lateral sides of the control unit **16** are parallel to the downwardly sloping linear portions **52ad, 52bd**, the control unit **16** is mounted completely away from an upper side of the standard household table.”

Independent claim 17 has been amended merely to include subject matter set forth in dependent claim 22 as previously presented, and now includes:

“a pair of left and right sub-frames **54a, 54b**, each of which is connected to a roughly central part of the corresponding downwardly sloping linear portion **52ad, 52bd** in a position that is directly above the corresponding horizontal linear portion **52ah, 52bh** and extending in a direction that is away from the operator of the apparatus and that is substantially parallel to the corresponding horizontal linear portion **52ah, 52bh**; and

a control unit **16** for said system being mounted in a position directly between the downwardly sloping linear portions **52ad, 52bd** and having lateral sides having lengths which are parallel to the downwardly sloping linear portions **52ad, 52bd**,

the position of the control unit **16** being rearward with respect to each of the sub-frames **54a, 54b**, and rearward with respect to the fixing bolts **76** at the forward ends of the horizontal linear portions **52ah, 52bh**,

wherein said riding simulation apparatus is adapted to be mounted on a standard household table, and

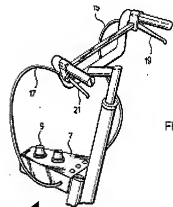
since the control unit **16** is mounted such that the lengths of the lateral sides of the control unit **16** are parallel to the downwardly sloping linear portions **52ad, 52bd**, the control unit **16** is mounted completely away from an upper side of the standard household table.”

See FIGS. 1 and 4, for example, for support.

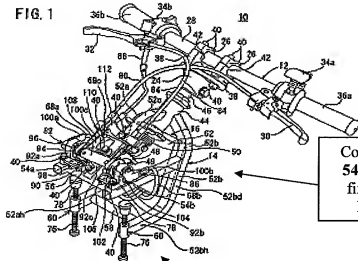
Reference numerals have been added above for emphasis only.

As conceded by the Examiner, Caprai fails to disclose sub-frames.

Ritchie FIGS. 1 and 4 are shown below to highlight the differences between Ritchie and the presently claimed invention as shown in FIG. 1.



Control box 3, 7 not rearward of the sub-frames. No fixing bolts are disclosed on the horizontal linear



Sub-frames **54a, 54b**, directly above
and parallel to the corresponding
horizontal linear portion **52ah, 52bh**

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refers to as “pair of sub-frames,” and this pair of pipes slopes downwardly toward the rider from the rear side the control box.

In addition, Ritchie fails to disclose or make obvious any of:

- a pair of left and right sub-frames **54a, 54b**, ... in a position that is directly above the corresponding horizontal linear portion **52ah, 52bh** and extending in a direction that is away from the operator of the apparatus and that is substantially parallel to the corresponding horizontal linear portion **52ah, 52bh**, or
- the position of the control unit **16** being rearward with respect to each of the sub-frames **54a, 54b**, and rearward with respect to the fixing bolts **76** at the forward ends of the horizontal linear portions **52ah, 52bh**, or
- wherein said riding simulation apparatus is adapted to be mounted on a standard household table, and

since the control unit **16** is mounted such that the lengths of the lateral sides of the control unit **16** are parallel to the downwardly sloping linear portions **52ad, 52bd**, the control unit **16** is mounted completely away from an upper side of the standard household table.”

As the Examiner will note, Ritchie merely discloses a control box 3 having lateral sides with lengths extending forward from the front fork. (See Ritchie FIG. 4 above.)

Thus, Ritchie cannot make up for the deficiency of Caprai to reject **independent claims 1 and 17**.

Further, on page 11 of the Office Action the Examiner appears to confuse fixing bolts 76 of claim 17 with attaching bolts 72 connecting the flange portions 70 to the main frames (as set forth in claim 12). Fixing bolts in claim 17 are shown in FIG. 1, and not in FIG. 3 as asserted by the Examiner.

At least for the reasons described above, no combination of Caprai and Ritchie can teach or suggest the combination of elements set forth in each of **independent claims 1 and 17**. Therefore, **independent claims 1 and 17** are in condition for allowance.

Dependent Claims

Dependent claims 5 and 22 are cancelled and dependent claim 8 has been amended to reflect the changes to independent claims 1 and 17. In addition, dependent claims 18 and 19 have been amended to address the issues under 35 U.S.C. 112, first paragraph.

All dependent claims are in condition for allowance due to their dependency from allowable independent claims, or due to the additional novel features set forth therein.

As other examples, each of **dependent claims 18 and 19** recites

“a forward end of the centrally located main frame disposed farthest away from the operator is connected to a cross frame bridging between forward ends of the sub-frames,

wherein a forward-most face of the control unit, which is located rearwardly and separately of the cross frame, faces a rear side of the cross frame.”

Neither Caprai nor Ritchie discloses a cross frame. As for Ritchie, the forward-most front face of video game (control unit) 3 certainly does not face a rear side of any part of the exercise bike 5.

Thus, **dependent claims 18 and 19** contain allowable subject matter.

As other examples, each of **dependent claims 20 and 21** recites

“wherein when the riding simulation system is viewed in a side elevation view, the left and right downwardly sloping linear portions can be seen to overlap the lengths of the left and right lateral sides of the control unit.

The Caprai fails to teach or suggest downwardly sloping portions of main frames. As can be seen in Ritchie FIGS. 1 and 4 above, Ritchie fails to teach or suggest the subject matter of **dependent claims 20 and 21**

Thus, **dependent claims 20 and 21** contain allowable subject matter.

Prima Facie case of Obviousness not Established

The Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness in the rejection of the claims of the present invention.

In numerous instances in the Office Action the Examiner makes unsubstantiated statements, including

Page 6: “Therefore, the system of the prior art appears to work well for the intended purpose.”

Page 6: “Caprai does not explicitly disclose “a stopper mechanism having a fixing bolt provided at a forward end of (each of) the horizontal portions. However, the functional limitation. . . (e.g. see Para 0035 of Applicant’s original disclosure.)”

Page 10: “Ritchie further implicitly teaches the limitation, ...”

Page 12: "Regarding the recited feature, "the control unit is mounted completely away from an upper side of the elevated mounting surface", this appears to be a mere rearrangement of parts."

Page 13: "It is also very apparent (to the Examiner) from the teaching of the prior art that the control unit described in the references is positioned in such a way that the field of view of the operator is not restricted."

Page 14: "However, the above feature does not change or affect the principle of operation of the control unit..."

In making statements such as those above, it appears that the Examiner is using hindsight during the analysis of the cited references.

The Examiner states that even though the presently claimed elements, and the structural relationship among the claimed elements, are not disclosed or suggested by the cited reference, that is apparent (to the Examiner) that the different elements and different structural relationships discloses in the cited references serve the "intended purpose" (as imagined by the Examiner).

Such statements to do not establish a *prima facie* case of obviousness.

In addition, the Examiner statements that a claimed element is "implicit" even though "not explicitly disclosed," is not sufficient to qualify a reference as being a valid prior art reference.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade*

Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

What is “implicit” or “inherent” must be explicitly disclosed.

In Summary

The burden of proof for establishing a *prima facie* case of obviousness is the responsibility of the Examiner. The Examiner has not done so.

At least for the reasons included above, and the many arguments presented in the previous response, the Applicant submits that the rejections under 103(a) made in the Office Action are not proper and should be withdrawn.

All pending claims are now believed to be in condition for allowance.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are respectfully requested.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

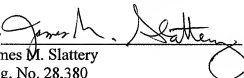
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 208-4030 (direct line).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

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Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
James M. Slattery
Reg. No. 28,380
P. O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

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